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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,373	08/28/2001	Matthias Mulzer	REDS0004	6080
22862	7590	01/04/2005	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			PROCTOR, JASON SCOTT	
			ART UNIT	PAPER NUMBER
			2123	

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/941,373	MULZER, MATTHIAS	
	Examiner Jason Proctor	Art Unit 2123	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 August 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____.	6) <input type="checkbox"/> Other: ____.

DETAILED ACTION

1. Claims 1-11 have been submitted for examination.
2. Claims 1-11 have been rejected.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract in the instant application repeats information given in the title.

Claim Objections

5. Claim 1 is objected to because of the following informalities: The parenthetical phrase of claim 1 would render the surrounding limitation vague and indefinite. Examiner will presume the parenthesis are a typographical error and consider this limitation without the parenthesis, as in claims 3 and 10. Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-11 rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

8. Claim 1 recites a method of providing data, however the limitations are directed toward the definition of the data. As such, the claimed invention is nonfunctional descriptive material and therefore nonstatutory. The dependent claim fails to direct the invention to statutory subject matter. See MPEP 2106(IV)(B)(1).

9. Claim 3 recites a method of using data, however the limitations are directed toward the definition of the data. As such, the claimed invention is nonfunctional descriptive material and therefore nonstatutory. The dependent claims fail to direct the invention to statutory subject matter. See MPEP 2106(IV)(B)(1).

10. Regarding claims 8 and 9, MPEP 2106(IV)(B)(1) states:

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material.

11. Claim 8 is directed to computer software and is therefore nonstatutory functional descriptive material. Claim 9 recites a computer that is programmed to perform the method of claim 3, however makes no limitation regarding a computer-readable medium and therefore must be regarded as computer software and nonstatutory functional descriptive material.

12. Regarding claim 10, the limitations recite a computer-readable medium, however the limitations are directed only toward defining data stored on the computer-readable medium. The claimed invention is therefore nonstatutory nonfunctional descriptive material. The dependent claim fails to direct the invention to statutory subject matter. See MPEP 2106(IV)(B)(1).

13. To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. § 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Claim 1, 3, and 10 recite the phrase "defining a predefined part for use in a CAD model processed by a CAD program" which renders the claim vague and indefinite. It is unknown what "defining a predefined part" means and whether this is a constructive task or rather denoting that the part is suitable for use by a CAD program. It is unknown to the Examiner how to determine if an example of prior art teaches "defining a predefined part".

17. Regarding claim 7, the phrase “defining and/or changing the size of the predefined part” renders the scope of the claim vague and indefinite. It is unclear to the Examiner what the scope of the claimed invention is and whether a similar invention that performs only one of these functions should be understood as infringing upon this claim limitation.

18. Claims not specifically mentioned are rejected by virtue of their dependence.

Claim Interpretation

19. In the interest of compact prosecution, examiner makes the following claim interpretations in order to apply prior art to the claims. See *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984).

20. Regarding claims 1, 3, and 10, the phrase “defining a predefined part for use in a CAD model processed by a CAD program” is interpreted as “defining a part for use in a computer aided design (CAD) model processed by a CAD program”.

21. Regarding claim 7, the phrase “defining and/or changing the size of the predefined part” is interpreted as “defining or changing the size of the predefined part” in order to grant the broadest reasonable interpretation to the claim language.

Claim Rejections - 35 USC § 102

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

23. Claims 1-6 and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Coggins US Patent No. 5,367,622.

24. Regarding claims 1, 3, and 10, Coggins teaches an computer-implemented system for operating a computer aided design system (column 5, line 45 – column 6, line 6; column 3, lines 8-31) comprising of a catalog of components (column 3, lines 50 – 62; column 7, line 56 – column 8, line 8), wherein the components have insertion points defining where and at what orientation the components should be connected as well as accessory attachment points (column 4, lines 17-34). The accessory attachment points are functionally equivalent to an insertion point, are illustrated identically to an insertion point (Fig. 5, references 140, 146), and therefore constitute a plurality of insertion points.

25. Regarding claims 2, 4, and 11, Coggins teaches the insertion points comprise a location of the insertion point on the component and defines a coordinate system of the component (column 4, lines 17-34; column 8, line 63 – column 9, line 14).

26. Regarding claim 5, Coggins teaches that the insertion point is selected for inserting the component into the CAD model (column 3, lines 12-31; column 4, lines 18-34).

27. Regarding claim 6, Coggins teaches that the component is inserted into the CAD model such that the location of the insertion point matches a reference point in the CAD model and the orientation of the component matches that of the reference point in the

CAD model (column 3, lines 12-25; column 4, lines 18-34; column 8, line 63 – column 9, line 14).

28. Regarding claim 8, Coggins teaches that the disclosed invention works with a CAD program (column 7, lines 25-34).

29. Regarding claim 9, Coggins teaches that the disclosed invention is embodied on a computer system (column 5, line 45 – column 6, line 6).

Claim Rejections - 35 USC § 103

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Coggins.

32. Regarding claim 7, Coggins does not explicitly teach changing the size of the component while the insertion point remains at the same relative location on the component.

33. Coggins does teach that the catalog may contain components of various sizes (column 9, line 56 – column 8, line 23). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention in combination with his own knowledge of the particular art to modify the teachings of Coggins to arrive at a system where it is possible to change the size of the components rather than to store

components of various sizes in the catalog. Such a modification would save space in the catalog and provide the user with more design options if the existing components were of an inconvenient size. Further, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention in combination with his own knowledge of the particular art to keep the insertion points located at the same features of the components regardless of size because they would be expected to be assembled in a similar fashion despite the change in size. The combined invention could be achieved by including a simple resize function in the invention disclosed by Coggins where the location of the insertion points remains in a fixed position throughout the resizing operation.

Conclusion

Art considered pertinent by the examiner but not applied has been cited on form PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Proctor whose telephone number is (571) 272-3713. The examiner can normally be reached on 8:30 am-4:30 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin J Teska can be reached on (571) 272-3716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason Proctor
Examiner
Art Unit 2123

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A handwritten signature in black ink, appearing to read "JEFFREY T. ESA". To the right of the signature, the text "SUPERVISORY" and "PATENT EXAMINER" is printed vertically.